

Remarks

Reexamination and reconsideration of this application, as amended, is requested. Claims 1, 3 -13 and 15 - 25 remain in the application. No new claims have been added.

Applicants believe there is a two month extension needed for this response and the Patent Office is authorized to charge deposit account #50-0221.

Response to the 35 U.S.C. §102(b)/103(a) Rejection

Claims 1, 5, 6, 12, 14, 23, 26, 27, 29, 32 and 33 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 8, 16 and 19 of U.S. Patent No. 6,600,726.

Claim 14 was rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claims 1, 2, 5, 6, 12, 13, 27 was rejected under 35 U.S.C. 102(b) as being anticipated by Heidari.

Claim 29 was rejected under 35 U.S.C. 102(b) as being anticipated by Shaffer et al.

Claims 3, 4, 6-9, 15-23, 26 were rejected under 35 U.S.C. 103(a) as being unpatentable over Heidari in view of Dean et al.

Claims 10, 11, 24, 25, 27, 28 and 30-33 were rejected under 35 U.S.C. 103(a) as being unpatentable over Heidari in view of Dean et al as applied to claims 1 and 23 above, and further in view of Ault et al.

Applicants believe these rejections have been overcome in view of the amendments made above and the remarks that follow.

As is well-established, in order to successfully assert a *prima facie* case of anticipation, the Office Action must provide a single prior art document that includes every element and limitation of the claim or claims being rejected. Therefore, if even one element or limitation is missing from the cited document, the Office Action has not succeeded in making a *prima facie* case.

Applicants begin with amended claim 1. Claim 1, as amended specifically recites:

1. (Currently Amended) An apparatus comprising:

a wireless transceiver having a joint signal transmit/receive section, and a plurality of signal up/down conversion sections sharing said joint signal transmit/receive section, to selectively transmit and receive signals in accordance with a first and a second protocol, in a coordinated manner, to and from network devices of a first and a second wireless network; and

a controller coupled to the wireless transceiver to control said wireless transceiver to perform said transmits and receives in said coordinated manner, wherein the controller, in a coordinated manner, selectively couples a first signal up conversion section to the joint signal transmit/receive section to perform said transmit of signals to network device(s) of said first wireless network, while keeping a second signal up conversion section decoupled from the joint signal transmit/receive section preventing signals from being transmitted to network device(s) of said second wireless network.

It is respectfully asserted that, as one example, Heidari fails to meet either expressly or inherently the limitation that the transceiver include a controller coupled to the wireless

transceiver to control said wireless transceiver to perform said transmits and receives in said coordinated manner, wherein the controller, in a coordinated manner, selectively couples a first signal up conversion section to the joint signal transmit/receive section to perform said transmit of signals to network device(s) of said first wireless network, while keeping a second signal up conversion section decoupled from the joint signal transmit/receive section preventing signals from being transmitted to network device(s) of said second wireless network.

As described by the Office Action, Heidari teaches that switches are used to couple and de-couple connection with the interconnected transmitter/receiver and the switches used for selecting and switches are controlled by micro-controller. In particular, as recited in the '893 patent, "the digital compression circuitry, which is employed for outgoing voice signals, and the digital expansion circuitry, which is employed for incoming voice signals, constitute a vocoder operative under control of a microcontroller unit." Further, the '893 provides that in order to introduce uniformity of voice quality during both analog and digital modes of communication, the telephone includes circuitry for inserting the vocoder circuitry into the analog branch of the receive channel as a speech compensator with the compression and expansion circuitry operated in a back-to-back arrangement. The input and output signal formats of the speech compensator are identical, but the resulting output signal of the compensator has a digitally processed voice quality. Thereby, the digitally processed voice quality is present in both analog and digital modes of communication so as to eliminate a disturbance in change of voice quality during a hand-off between the two communication modes." Thus, the microcontroller (i.e., controller) of Heidari enables inserting the vocoder circuitry into the analog branch of the receive channel as a speech compensator with the compression and expansion circuitry operated in a back-to-back arrangement. The object of this arrangement is combine the two protocols into one transmission

to "eliminate a disturbance in change of voice quality during a hand-off between two communication modes".

This is in contrast to the present invention wherein the controller provides that "while keeping a second signal up conversion section decoupled from the joint signal transmit/receive section preventing signals from being transmitted to network device(s) of said second wireless network. Heidari teaches away from this as the object is to make the analog and digital (i.e. two protocols) indistinguishable by combining the two by inserting a vocoder into the analog branch. Switches 58 and 60 of FIG. 1 along with analog transmit 40, digital transmit 42, digital receive 68, analog receive 46 facilitate this by passing through RF Unit 16 which, by necessity, has duplexer 54 to combine the signals. Again, the signals are combined in Heidari to transmit both protocols (digital and analog [which is digitized]) in one transmission, as opposed to the present invention which prevents signals from being transmitted to devices which use a second protocol.

Independent Claim 17 provides:

coupling a first signal up conversion section to the joint signal transmit/receive section to perform transmit of signals to network device(s) of a first wireless network in accordance with a first protocol, while keeping a second signal up conversion section de-coupled from the joint signal transmit/receive section to prevent signals from being transmitted to network device(s) of a second wireless network in accordance with a second protocol;

As claim 17 requires "keeping a second signal up conversion section de-coupled from the joint signal transmit/receive section to prevent signals from being transmitted to network

device(s) of a second wireless network in accordance with a second protocol", and claim 23 requires "automatically coordinate selective transmit and receive operations conducted in accordance with said two protocols to enable the third apparatus to operate with said first and second apparatuses at the same time", for the reasons set forth above and for the followings reasons, Applicant respectfully submits that the 103(a) rejections for claims 17 and 23 have been traversed.

Applicants respectfully submit that the Examiner cannot satisfy the basic requirements of a prima facie case of obviousness by using Heidari and Dean et al. to reject pending independent Claims 17 and 23. For the Examiner to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the references. Second, there must be some reasonable expectation of success. Finally, the references when combined must teach or suggest all of the claimed limitations. Manual of Patent Examining Procedure, Section 2143.

As stated above Heidari teaches away from the present invention by combining the two protocols into one transmission or reception, and there is no suggestion or motivation to combine Dean or Heidari. For the same reason, there would be no reasonable expectation of success, because the object and operations of the two inventions are significantly different. Further, for the reasons set forth above, Dean and Headari when combined would not teach or suggest all of the claimed limitations. Specifically they would not teach:

while keeping a second signal up conversion section de-coupled from the joint signal transmit/receive section to prevent signals from being transmitted to

network device(s) of a second wireless network in accordance with a second protocol; (claim 17)

and

automatically coordinate selective transmit and receive operations conducted in accordance with said two protocols to enable the third apparatus to operate with said first and second apparatuses at the same time. (claim 23)

Therefore, Applicants respectfully submit that Heidari cannot anticipate Applicants' independent claims and corresponding dependent claims. In addition, Applicants respectfully submit that Heidari when combined with the other documents cannot make claims 17 or 23 nor the dependent claims obvious

PATENT APPLICATION

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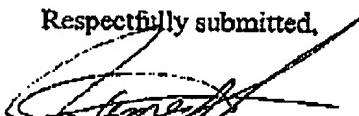
Conclusion

The foregoing is submitted as a full and complete response to the Office Action mailed January 21, 2004, and it is submitted that claims 1, 3 – 13 and 15 – 25 are in condition for allowance. Reconsideration of the rejection is requested.

Should it be determined that an additional fee is due under 37 CFR §§1.16 or 1.17, or any excess fee has been received, please charge that fee or credit the amount of overcharge to deposit account no. 50-0221.

If the Examiner believes that there are any informalities which can be corrected by an Examiner's amendment, a telephone call to the undersigned at (202) 607-4607 is respectfully solicited.

Respectfully submitted,


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